

REMARKS

Remarks to follow are numbered to correspond to the office action.

Claims Rejections - 35 USC § 103, Response to Arguments

1-5. Applicant's claims 1-10, 12-16, 21, 23-25, 27 and 28 are rejected as being obvious in light of Stonehouse in view of Daenen. Applicant appreciates that in point 5, examiner has withdrawn the earlier rejection based on Sonnabend and Chandler. However, the present rejection based on the newly-cited design patents of Stonehouse and Daenen is equally, if not even more unpersuasive. This action contains errors in both its factual findings and its legal conclusion of obviousness, which will be reviewed in turn below.

Factual Defects in the §103 Rejection

Examiner states that the base reference Stonehouse discloses, among other things, "an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter, from more than [two - sic] side cross-sections." However, there is nothing in any of the patent drawings of Stonehouse which discloses any information about the inner side surface, because all of the drawings illustrate only

the *outer* side surface. Examiner is making the unsupported supposition that the inner surface must mirror the outer surface, yet there is no factual basis for this. Furthermore, since this is a *design* patent devoted to the *external visual* appearance of an article of manufacture (referred to as a "drinking vessel") and not its functional utility, there would in fact be no calling to illustrate the interior surface of this article of manufacture, because that has little if anything to do with how this drinking vessel would appear to the human eye.

And, as a design patent, there is no text in Stonehouse to provide any further insight on this question. Therefore, examiner's foregoing statement is not supported, and as a factual matter, Stonehouse does *not* disclose this claim element as examiner states.

Examiner further states that the base reference Stonehouse discloses "an inward angle comprising a less than 90 degree angle tangential to any point along said inner side surface from said inner mid section diameter to said inner upper section diameter, from more than two side cross-sections, wherein said inward angle is greater than zero degrees at said open top."

The "inward angle" as defined by applicant in the disclosure and illustrated by element **107** in applicant's drawings, is specified along the *inner* side surface, not the *outer* side surface. Once again, examiner makes the unsupported supposition that the *inner*

surface features must of the Stonehouse article of manufacture must match the features along the outer surface, without any support in the design drawings i.e. claims, and without any text two provide support. Further, as a matter of functional utility, it would be rather clumsy to drink from a drinking vessel in which the inner side surface tacked inward as is required in this claim element. Therefore, examiner's statement as to this claim element is not true. As a factual matter, Stonehouse does not disclose this claim element as examiner states.

Applicant agrees that Stonehouse does not disclose an outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter, from more than two side cross-sections, or the rigid material. However, it is unclear what legal status is to be afforded to examiner's statement about what is "conventionally known in the art." Is examiner taking official notice of something? Is there a reference upon which this assertion is based? It would be helpful as a matter of due process to be provided more information upon which to respond to this statement.

Further, although examiner speaks about what is conventionally well known in the "art of drinking vessels," the fact bears emphasis that applicant's invention is not a drinking

vessel and has an entirely different functional purpose than a drinking vessel and so - other than the fact that it must be capable of holding fluids - is motivated by an entirely different set of design considerations.

5 Turning to Daenen's "Tumbler or the Like," examiner states that this design patent discloses "an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter, from more than
10 [two - sic] side cross-sections." This is simply not true. Daenen, which in contrast to Stonehouse does appear to be drawn so as to illustrate the inner as well as outer surface contours, disclose precisely the opposite, namely, "an inner side surface comprising an inner mid section diameter thereof continuing
15 inwardly to an inner upper section diameter thereof which is larger than said inner mid section diameter, from more than [two] side cross-sections." Contrary to what examiner states, Daenen simply does not disclose this claim element.

Examiner further states that Daenen discloses an "outer
20 side surface further comprising an outer diameter thereof which, between said outer lower section diameter and an outer upper section diameter thereof, substantially never increases when moving from any lower circumference thereof to any higher circumference thereof, from more than two side cross-sections."

This is also simply not true. Except from the very bottom portion of the Daenen device, the outer diameter over more than 90% of the vertical rise of this article of manufacture always increases when moving from any lower circumference thereof to any higher circumference thereof. This is completely opposite to what examiner asserts. Daenen simply does not disclose this claim element, and in fact, discloses the precise opposite.

In sum, based on all of the foregoing, as a factual matter, Stonehouse and Daenen, even when taken together, do not disclose all the elements of applicant's independent claim as would be required to sustain a 103 rejection (and we have not yet reached the legal question whether these can be so combined).

Therefore, applicant respectfully request withdrawal of this rejection based on the above-noted factual defects.

Legal Defects in the §103 Rejection

In *KSR v. Teleflex, Inc.*, the U.S. Supreme Court clarified that when considering an obviousness rejection under 35 U.S.C. §103, a) the Graham factors still apply; b) the "teaching, suggestion, or motivation" test still applies, but is not the sole, rigid basis upon which to establish obviousness; and c) no matter what an examiner's rationale for rejection, it remains "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the

[prior art] elements" in the manner claimed.

In the present case, after asserting in inaccurate factual recitation of the claim elements disclosed in each of Stonehouse and Daenen as discussed above, examiner proceeds to issue the
5 103 rejection with no more than the bald, legally-insufficient assertion that "it would have been obvious to combine" these two references to arrive at applicant's invention. Examiner identifies no reason that would have prompted a person of ordinary skill in the relevant field to combine the prior art
10 elements in the manner claimed by applicant. This, standing by itself, and in addition to the aforementioned factual errors, is further reason why the 103 rejection is legally insufficient, and so should be withdrawn.

For illustration, let us now consider some of the
15 rationales which may be used to establish a *prima facie* obviousness rejection. First, in KSR, the Supreme Court makes clear that the teaching, motivation or suggestion test does continue to apply. But in this case, there is in fact no teaching, suggestion or motivation to combine Stonehouse and
20 Daenen references to arrive at applicant's claimed invention. First, both of these references, being design patents, are for the visual appearances of drinking devices, not for the functional characteristics of applicant's anti-splash, anti-spill apparatus for holding fluids during a surgical procedure.

The motivating factors behind the design of a drinking device - which have previously been discussed in the record for this case - are simply not the same as those behind a device for holding surgical fluids such as that which applicant has invented.

5 Further, also because these are design patents devoid of any descriptive material having to do with function other than the two titles which both appear to indicate a function related to beverage consumption, there is nothing at all in either of these two design patents to motivate, disclose or suggest their
10 combination. So there is in fact no teaching, suggestion, or motivation to combine these two references, in either of these two references.

Of course, as KSR makes clear, other tests could also be applied to establish a *prima facie* case of obviousness. For
15 example, KSR permit a *prima facie* case to be establish by the rationale that it would have been obvious to combine prior art elements according to known methods to yield predictable results. Or, that a claimed invention merely combines prior art elements according to known methods to yield predictable
20 results. Or, that the claimed invention is for a technique for improving a particular class of devices which was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of that technique for improvement in other situations. Or, that a known technique is being applied

to a known device ready for improvement to yield predictable results. Or, that it would have been "obvious to try" applicant's approach by choosing from a finite number of predictable solutions. Or, that a claim would have been obvious because the design incentives or market forces provide a reason to make the adaptation and the invention resulted from application of the prior knowledge in a predictable manner.

Nevertheless, none of these rationales, nor any other rationale, has been cited by examiner to establish a *prima facie* case of obviousness. First, it is examiner's burden to establish such a *prima facie* case which has not been done here, and applicant need not rebut such a rationale nor is it even logically possible to do so, until an examiner has asserted and explained it. Secondly, in applicant's view, were they to be asserted, none of the aforementioned rationales applies to applicant's invention. Therefore, once again, this rejection cannot be sustained under section 103.

Finally, counsel cannot conclude without making a more global observation about the invention as claimed in this case and the prior art that has been cited and the attempts which have been made to combine the prior art references, not only in this office action, but in previous office actions.

Applicant's invention, like all inventions, must be taken "as a whole," and cannot not be subjected to "impermissible

hindsight." This is still the law in the wake of KSR. Loosely speaking, and referring to Figure 1 of applicant's drawings, applicant's invention combines, into a unitary device, two "halves." First, there is a "top" half characterized by a gradually-narrowing region especially toward the top of the apparatus along the inner surface, which deters spillage when the device is seated on a flat surface (particularly a surgical table), and which, as has been noted in the record before, would prove a rather clumsy structure for any drinking apparatus, especially so given the size of applicant's device, as is specified in dependent claims 12 and 13 (in terms of fluid content) and in dependent claims 15 and 16 (in terms of linear dimensions). Second, there is a "bottom" half characterized by a gradual widening of the base, as one approaches the bottom of the device, which provides stability when the device is resting on a surgical table but when fluid is being extracted therefrom and movement from the fluid extraction can cause the device to tip and spill.

Respectfully, despite a first office action, a first final office action, an office action following an RCE, and now the present final office action following the RCE, and despite the literally millions of drinking devices that undoubtedly have been designed by humankind over the course of time, examiner has repeatedly failed to find a single example of a drinking device

or any other fluid holding device which combines all of the claimed elements of applicant's invention. And, this is indeed a crowded art area in which there are undoubtedly countless devices among which examiner could presumably find such a device
5 if it had been invented heretofore. And, this is not a highly technical or esoteric art area, and so such a device, were to exist, could have been invented by literally millions if not billions of people. The fact that a device which combines all the features of applicant's invention does not appear to have
10 been invented despite the tremendous opportunity for such a device to have been invented, provides virtually irrefutable evidence that applicant's inventions really is NOT obvious as examiner asserts.

To use an analogy in keeping with the "top" and "bottom" halves as discussed above, there are many types of fish (bottom half) in the world and many type of female human beings (top half) in the world. Applicant has invented what by analogy is a "mermaid" (top and bottom halves all in one), and examiner keeps finding and citing references for numerous types of fish, and
20 for numerous types of female humans, in an effort to assert that it "would have been obvious" for someone to invent a mermaid. Yet, despite countless opportunities over time for a mermaids to have evolved given all the fish and all the female humans existing in the world over centuries of time, such has never

happened, and this points strongly away from the asserted obviousness of the combination.

In sum, examiner has failed to present any prior art of record to sustain a finding of obviousness, and in the current
5 action, has both failed to lay a proper factual foundation, and has failed to establish a *prima facie* legal case.

As such, applicant respectfully request withdrawal of the rejection in this action, and allowance of all claims.

10 Dependent Claims

As noted above, dependent claims 12 and 13 specify the sizing of applicant's device in terms of fluid content, while dependent claims 15 and 16 specify this sizing in terms of linear dimensions. These claims were all rejected with the
15 observation that it would have been obvious to "optimize" the fluid holding volume and linear dimensions of the device in order to "maximize" the functionality of the device, and that "only the expected results would be obtained."

However, as has also been previously stated on the record,
20 this is not true, given the particular configuration of applicant's device as disclosed and claimed. In particular, while examiner has repeatedly drawn on the art for drinking devices (which again, applicant's device is not), a drinking device with the inward curvature which is disclosed by applicant

at the top opening, would be exceptionally clumsy to drink from, and would especially be so at the size and fluid-holding capacity of applicant's device as specified in claims 12, 13, 15 and 16. Thus, a drinking device designed according to what
5 applicant has disclosed really cannot be strictly scaled in size without changing the "expected results," namely, that one can drink therefrom without serious physical inconvenience.

Put differently, if someone of ordinary skill in the art for beverage containers were to start with an ordinary-sized
10 beverage container in combination with the configuration disclosed by applicant and then scale down to the sizes recited in claims 12, 13, 15 and 16, more than "only the expected results" would be obtained, because the scaled-down device would become exceptionally clumsy to drink from as a result of the
15 downward scaling combined with the inward angling at the top. Therefore, there would be absolutely no motivation to scale down in this fashion because the result would be contrary to what is desired for the a beverage container. The motivation for such a scaled-down device with applicant's claimed configuration would
20 therefore have to then come from outside the art for beverage containers. As such, the recitations of claims 12, 13, 15 and 16 provide further patentable weight.

Based on the foregoing, applicant therefore respectfully requests allowance of claims 12, 13, 15 and 16.

Conclusion

6-7. As a result of the foregoing, applicant respectfully
requests withdrawal of the rejections and allowance of all
5 claims.

As noted earlier, if these amendments and remarks do not
place this application into condition for allowance, applicants'
counsel hereby respectfully requests a telephone interview with
examiner Kevin Joyner, following receipt of this reply, and
10 prior to issuance of an advisory office action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay R. Yablon". The signature is stylized with a large, looped initial "J" and a trailing flourish.

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